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Fort Collins, CO 80527-2400

EXAMINER

POPOVICI, DOV

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHELL S. SIMPSON, WARD S. FOSTER
and KRIS. R. LIVINGSTON

Appeal 2009-003209
Application 10/033,148
Technology Center 2600

Decided: June 30, 2009¹

Before JOSEPH F. RUGGIERO, MARC S. HOFF, and
ELENI MANTIS MERCADER, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from the Final Rejection of claims 16 and 26. Claims 1-15, 17-25, and 27 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

Rather than repeat the arguments of Appellants or the Examiner, we refer to the Appeal Brief (filed January 10, 2007), the Examiner's Answer (mailed May 17, 2007), and the Reply Brief (filed July 17, 2007). Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived (*see* 37 C.F.R. § 41.37(c)(1)(vii)).

Appellants' Invention

The invention claimed on appeal relates to a printing system that includes a personal computer and a printer having multiple output trays. The personal computer transmits a document to be printed to the printer and also displays an image of the printer while the printer is printing the document. The displayed image indicates the particular printer output tray that is receiving the document and further indicates the present capacity of the document receiving output tray to receive additional media. (*See generally* Spec. 1, ll. 18-28 and 9, ll. 5-22).

Claim 16 is illustrative of the invention and is reproduced as follows:

16. A server, comprising:

means for receiving a request from a client;

means for responding to the request by transmitting a program of computer readable instructions to the client, the program for enabling the client to:

use a specific printer having a plurality of output trays to print a document; and

display an indicator that indicates the identity of an output tray from the plurality of output trays that receives the document and the present capacity of the output tray that is receiving the document to accept additional media;

wherein the server is the printer.

The Examiner's Rejection

The Examiner relies on the following prior art reference to show unpatentability:

Nozawa	US 6,781,709 B2	Aug. 24, 2004 (filed Dec. 12, 2000)
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Claims 16 and 26 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Nozawa.

ISSUE

The pivotal issue before us in making the determination as to whether the Examiner erred in rejecting appealed claims 16 and 26 under 35 U.S.C. § 102(e), is whether Appellants have demonstrated that the Examiner erred in determining that Nozawa discloses a printing system with display that indicates the identity of an output tray that is to receive a printed document along with an indication of the present capacity of the document receiving output tray.

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Nozawa discloses (Figs. 1-3, col. 8, l. 3-col. 9, l. 3 and col. 8, l. 25-col. 9, l. 65) a printing system that responds to a request by a client to enable the client to use a specific printer having a plurality of output trays to print a document.

2. Nozawa further discloses (Figs. 3, 18, and 19 and col. 9, l. 66-col. 10, l. 65) the display of an indicator that indicates the identity of an output tray from the plurality of output trays that receives the printed document.

3. Also disclosed (Fig. 10 and col. 14, ll. 31-56) by Nozawa is a displayed “Output Paper Remains” indicator which indicates that paper remains in a receiving output tray from a previous print job.

4. Nozawa further discloses (Fig. 12 and col. 15, ll. 28-43) a displayed indicator of which output trays are allocated to specific users and may not be available for selection by a particular user for a particular print job.

PRINCIPLES OF LAW

It is well settled that in order for the Examiner to establish a *prima facie* case of anticipation, each and every element of the claimed invention, arranged as required by the claim, must be found in a single prior art reference, either expressly or under the principles of inherency. *See generally In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997); *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677 (Fed. Cir. 1988);

Lindemann Maschinenfabrik GMBH v. Am. Hoist & Derrick Co., 730 F.2d 1452, 1458 (Fed. Cir. 1984). “Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient.”” *Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991) (quoting *Hansgirg v. Kemmer*, 102 F.2d 212, 214 (CCPA 1939). The reference must teach each and every claim limitation, it must be enabling, and it must describe the claimed subject matter sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 1346 (Fed. Cir. 2000); *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994).

ANALYSIS

Appellants’ arguments in response to the Examiner’s anticipation rejection, based on Nozawa, of appealed independent claims 16 and 26 assert that the Examiner has not shown how each of the claimed features is present in the disclosure of Nozawa so as to establish a *prima facie* case of anticipation. Appellants’ arguments (App. Br. 4-6; Reply Br. 2-5) focus on the contention that, in contrast to the requirements of claims 16 and 26, Nozawa provides no disclosure of a display that indicates the present capacity of the output tray that is receiving the printed document.

We agree with Appellants. The Examiner makes reference (Ans. 8) to the portion of the disclosure of Nozawa (col. 14, ll. 31-56) which describes an “Output Paper Remains” indicator. Appellants have correctly asserted (Reply Br. 2-4), however, that this displayed message merely provides an indication that paper remains in an output tray from a previous

printing job, not an indication of the present capacity of the output tray to receive additional media as claimed.

The Examiner also directs attention to Figure 12 of Nozawa and the accompanying description at column 15, lines 28-44 which discloses a display that provides an indication of which printer output trays are available to accept printed documents and which are not. According to the Examiner (Ans. 8), Nozawa's disclosed indication as to which output trays are capable of accepting printed documents provides an indication of the "capacity" of the trays to accept printed documents.

We are not persuaded by the Examiner's stated position. We agree with Appellants (Reply Br. 4-5) that the mere indication that an output tray cannot be selected since it is assigned to other users, as disclosed by Nozawa, cannot be reasonably interpreted as providing an indication of the present capacity of an output tray that is receiving documents from a print job as set forth in appealed claims 16 and 26.

We make the observation that the language of independent claim 26 does not contain the limitation of claim 16 which qualifies the claimed output tray capacity as the capacity "to accept additional media." As previously discussed however, claim 26 does require that the indicated capacity be that of the output tray that is presently receiving documents, a feature which is not taught or suggested by Nozawa.

In view of the above discussion, since Appellants' arguments have demonstrated that the Examiner erred in determining that all of the claim limitations are present in the disclosure of Nozawa, we do not sustain the Examiner's 35 U.S.C. § 102(e) rejection of appealed independent claims 16 and 26.

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CONCLUSION

Based on the findings of facts and analysis above, we conclude that Appellants have shown that the Examiner erred in rejecting claims 16 and 26 for anticipation under 35 U.S.C. § 102(e).

DECISION

The Examiner's decision rejecting claims 16 and 26 under 35 U.S.C. § 102(e) is reversed.

REVERSED

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